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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,353	10/10/2003	Larry J. Pacey	WMS-028	3337
70243	7590	06/25/2007		
NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER MCCULLOCH JR, WILLIAM H	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 06/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/684,353

Applicant(s)

PACEY, LARRY J.

Examiner

William H. McCulloch Jr.

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/10/2003, 6/20/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) with mailroom dates 10/10/2003 and 6/20/2005 (third party submission) were filed in compliance with the provisions of 37 CFR 1.97-1.99. Accordingly, the examiner has considered the information disclosure statements.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 9-19, 21-28 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,620,045 to Berman et al. (hereinafter Berman).

Regarding claims 1 and 17, Berman describes a method of conducting a wagering base game comprising: receiving a wager to play the wagering base game (see at least 8:15-24 and 9:49-10:10); detecting a winning outcome to the wagering base game, the winning outcome resulting in winning credits (see at least 8:15-24 and 9:49-10:10); providing a first award option to a player of the wagering base game, the first award option displayed on a video display of the gaming machine (see at least fig. 7 and description thereof); in response to the first award option being exercised by the

player, precluding the player from receiving the winning credits and awarding the first award option to the player (see at least 9:49-10:47). Note that the outcome of the spinning reels is initially concealed from the player.

Regarding claim 23, Berman teaches a gaming machine for conducting a wagering base game, the gaming machine comprising: a value input device (11:7-14); a video display for displaying video images associated with the wagering base game (see at least 17:42-64); and a controller operatively coupled to the value input device and the video display, the controller comprising a processor and a memory coupled to the processor (see at least 16:43-61 and 17:42-64). The controller implements the method taught in relation to claims 1 and 17, as described above.

Regarding claims 2, 10, and 24, Berman teaches that the gaming machine is a video slot machine and that the first award option comprises at least one free reel spin (see at least fig. 7, 2:3-15, and 9:49-10:47). The citation further shows that Berman teaches a first award option that comprises an occurrence of a bonus game.

Regarding claims 3, 18, and 25, Berman teaches that a first award option comprises base game play not requiring a wager (see at least 2:3-15 and 9:49-10:47).

Regarding claims 4 and 26, Berman teaches a first award option further comprising an occurrence of a multiplied winning outcome associated with the base game play not requiring a wager (see at least multiplier values in element 712 of fig. 7).

Regarding claims 5, 19, and 27, Berman teaches a first award option further comprising a credit amount, as is demonstrated by the outcome of a bonus game payable with a number of credits (see *Id.*)

Regarding claims 6 and 28, Berman teaches a first award option further comprising an occurrence of at least one enhanced symbol associated with the base game play not requiring a wager (see at least 2:3-15 and 6:7-13).

Regarding claim 11, Berman further describes a bonus game comprising: providing a plurality of pick tiles on the video display, each of the plurality of pick tiles associated with a hidden credit award (see at least 2:15-20); detecting player selection of a first pick tile of the plurality of pick tiles, player selection of the first pick tile revealing a first credit award to the player (see at least 2:15-20); providing a first bonus award option to the player (see at least fig. 7 and 9:49-10:47); and in response to the first bonus award option being exercised by the player, precluding the player from receiving the first credit award and awarding the first bonus award option to the player (see at least 9:49-10:60).

Regarding claims 9, 12, 21, and 22, Berman teaches a first bonus award option comprises bonus award credits, the bonus award credits being greater than the first credit award (see at least 15:18-27).

Regarding claim 13, Berman teaches precluding the player from selecting a second pick tile of the plurality of pick tiles in response to the first bonus award option being exercised by the player. Berman teaches such by virtue of the fact that the player may choose one of the pick tiles, which may prompt the player to select an award or an award option, thereby precluding the player from selecting a second pick tile if the player exercises the option.

Regarding claim 14, Berman teaches in response to the first bonus award option not being exercised by the player, enabling player selection of the second pick tile, the second pick tile associated with a second credit award. Berman teaches such by virtue of the fact that the player may continue pick tile selection. Claims 15 and 16 follow from claims 13 and 14 because they are a continuation of the method of allowing a player to choose an award (the sum or accumulation of credits) or a further award option. See above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 20, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman in view of U.S. 5,855,514 to Kamille (hereinafter Kamille).

Regarding claims 7, 20, and 29, Berman describes displaying a keep pay option on the video display, wherein selection of the keep pay option allows the player to keep the winning credits and precludes the player from exercising the option (see at least fig. 7 and 9:49-10:47); and displaying an option award meter on the video display, the option award meter providing a visual indication of a first award option value (see at least table 712 of fig. 7). Berman lacks in explicitly teaching displaying an animated character on the video display wherein the animated character appears to give verbal instructions to the player. In a related disclosure, Kamille shows animated characters

that appear to give verbal instructions to a player (see at least fig. 7B and related descriptions). It would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of Berman such that the instructions displayed on the display are given by an animated character, as is taught by Kamille, in order to increase overall player interactivity.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berman in view of U.S. 6,569,015 to Baerlocher et al. (hereinafter Baerlocher).

Berman teaches the invention substantially as described above, but lacks in explicitly teaching an option award meter comprising a circular disk having a plurality of colored wedges and a rotatable pointer, each of the plurality of colored wedges associated with a different value, the rotatable pointer indicating one of the plurality of colored wedges. In a related disclosure regarding offering players different awards, Baerlocher teaches an option award meter comprising a circular disk having a plurality of colored wedges and a rotatable pointer, each of the plurality of colored wedges associated with a different value, the rotatable pointer indicating one of the plurality of colored wedges (see at least fig. 4 and descriptions thereof). It would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of Berman by incorporating the circular disk taught by Baerlocher in order to clearly demonstrate to a player the outcome of a bonus game.

Citation of Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of References cited.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.
Examiner
Art Unit 3714
6/20/2007

wm

/Corbett Coburn/
Primary Examiner
AU 3714